

Attorney Docket No. 29402.17  
Customer No. 000027683

#### IV. REMARKS/ARGUMENTS

##### A. Status of the Application

Claims 1, 3-4, 8-18, 22, 25-26 and 30-37 are pending. Claims 1, 4, 22 and 26 have been amended. Claims 2, 5-7, 19-21, 23-24 and 27-29 are cancelled.

None of the amendments made herein is in response to the present rejection of the claims. Rather, the amendments made herein are made to enhance the Applicants' patent portfolio with claims of varying scope.

Reconsideration of claims 1, 3-4, 8-18, 22, 25-26 and 30-37 in light of the following remarks is respectfully requested.

##### B. Rejections under 35 U.S.C. § 102(b)

Claims 1-6, 8, 9, 12-15 and 20 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 6,013,323 to Klayder et al. ("Klayder '323"). As noted above, claims 2, 5-6 and 20 have been cancelled. Insofar as it may be applied to the present claims, this rejection is respectfully traversed.

Claim 1, as amended, is drawn to a sprayable fire dressing composition that includes an aqueous silicone microemulsion, an emulsifier system and a wetting agent. The aqueous silicone microemulsion includes amino functional silicone fluids having viscosities ranging from about 40 cSt to 500,000 cSt at room temperature dispersed in water. The emulsifier system includes surfactants and cosurfactants having interfacial functionalities to emulsify and disperse the silicone fluids in the water to the extent that the dispersed silicone fluids have a droplet size of from 10 to 100 microns. The wetting agent is a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent for reducing the surface tension of the silicone fluids. Claims 3-4, 8-9 and 12-15 depend, directly or indirectly, from and include all of the subject matter of claim 1.

Under the patent statute, a patent claim is invalid if the claimed invention is anticipated by a prior art reference under 35 U.S.C. § 102. The Federal Circuit has held that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Spada*, 911 F.2d 705, 15 U.S.P.Q.2d 1655 (Fed. Cir. 1990); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 7 U.S.P.Q.2d 1315 (Fed. Cir. 1988); *Orthokinetics, Inc. v.*

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*Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1665, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991) (emphasis added). Also, as provided in MPEP §2131, "[t]o anticipate a claim, the reference must teach every element of the claim...".

In light of the foregoing, Klayder '323 must disclose all of the elements of independent claim 1 and dependent claims 3-4, 8-9 and 12-15 to sustain the rejection under 35 U.S.C. §102(b). Klayder '323, however, does not disclose each and every element of independent claim 1. Specifically, Klayder '323 relates to aqueous based, gelled silicone compositions, particularly waxes and protectants that include an acrylate thickener. As disclosed at column 3, lines 9-11 of Klayder '323:

"The acrylate thickener imparts a suitable viscosity to the formulation so that it does not run or drip ..."

It is to be noted that the compositions of Klayder '323 are consistently described as being "gelled" and including either the acrylate thickener or a polymeric thickener in instances in which clarity is not required.

In contrast, claim 1 is directed to a sprayable rather than a gelled tire dressing composition. Klayder '323 does not disclose or suggest a sprayable composition. Accordingly, Klayder '323 does not disclose each and every element of independent claim 1.

Thus, as Klayder '323 does not disclose each and every element of claim 1, Applicants submit that the rejection of claim 1 under 35 U.S.C. §102(b) over Klayder '323 should be withdrawn.

As noted above, claims 3-4, 8-9 and 12-15 each depend, directly or indirectly, from and include the subject matter of claim 1. Therefore, the rejection of claims 3-4, 8-9 and 12-15 under 35 U.S.C. §102(b) over Klayder '323 should be withdrawn for at least the same reasons as noted above with respect to claim 1.

In view of the foregoing, Applicants request that the rejection of claims 1-6, 8, 9, 12-15, and 20 under 35 U.S.C. §102(b) over Klayder '323 be withdrawn.

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Claims 1, 3, 5, 6, 8, 18 and 19 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,759,983 to Mondin et al. ("Mondin '983"). As noted above, claims 5-6 and 19 have been cancelled. Insofar as it may be applied to the present claims, this rejection is respectfully traversed.

As noted above, claim 1, as amended, is drawn to a sprayable tire dressing composition that includes an aqueous silicone microemulsion, an emulsifier system and a wetting agent. The aqueous silicone microemulsion includes amino functional silicone fluids having viscosities ranging from about 40 cSt to 500,000 cSt at room temperature dispersed in water. The emulsifier system includes surfactants and cosurfactants having interfacial functionalities to emulsify and disperse the silicone fluids in the water to the extent that the dispersed silicone fluids have a droplet size of from 10 to 100 microns. The wetting agent is a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent for reducing the surface tension of the silicone fluids. Claims 3, 8 and 18 depend, directly or indirectly, from and include all of the subject matter of claim 1.

In light of the authorities noted above, Mondin '983 must disclose all of the elements of independent claim 1 as well as dependent claims 3, 8 and 18 to sustain the rejection under 35 U.S.C. § 102(b). Mondin '983, however, does not meet the standard required by the above authorities because Mondin '983 does not disclose each and every element of independent claim 1. Specifically, Mondin '983 relates to a microemulsion composition that includes an anionic surfactant, a polyalkylene oxide-modified polydimethyl siloxane, a secondary alcohol, an ethoxylated polyhydric alcohol type compound, magnesium sulfate heptahydrate, perfume and water.

In contrast to claim 1, Mondin '983 does not disclose or suggest an aqueous silicone microemulsion that includes amino functional silicone fluids having viscosities ranging from about 40 cSt to 500,000 cSt at room temperature dispersed in water.

Accordingly, Mondin '983 does not disclose each and every element of independent claim 1. Thus, as Mondin '983 does not disclose each and every element of claim 1, Applicants submit that the rejection of claim 1 under 35 U.S.C. § 102(b) over Mondin '983 should be withdrawn.

As noted above, claims 3, 8 and 18 each depend, directly or indirectly, from and include the subject matter of claim 1. Therefore, the rejection of claims 3, 8 and 18 under 35 U.S.C.

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§102(b) over Mondin '983 should be withdrawn for at least the same reasons as noted above with respect to claim 1.

In view of the foregoing, Applicants request that the rejection of claims 1, 3, 5, 6, 8, 18 and 19 under 35 U.S.C. §102(b) over Mondin '983 be withdrawn.

#### C. Rejections under 35 U.S.C. §103(a)

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) when combined must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaec*, 947 F.2d 488 (Fed. Cir. 1991). *See also* MPEP § 2142 at 2100-124. If even one of these criteria is not met, then the *prima facie* case fails.

#### A Motivation to Combine Must Be Shown

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). A mere conclusory statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levensgood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). The Federal Circuit in *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001), noted that "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense' to one of ordinary skill in the art. *Id.* at 1697. In other words, *In re Zurko* expressly proscribes any reliance by an examiner on what constitutes the knowledge of one skilled in the art, when the assessment of that knowledge is not based on any evidence in the record. More recently, the Federal Circuit

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reiterated this position in *In re Lee*, where it took issue with the fact that "neither the examiner nor the Board adequately supported the selection and combination of the ... references to render obvious that which [patentee] described." *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

If a proposed modification would render the prior art teaching being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification, *In re Gordon*, 734 F.2d 960 (Fed. Cir. 1984).

There Must Be a Reasonable Expectation of Success

The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986). Evidence showing that there is no reasonable expectation of success supports a finding of nonobviousness. *In re Rinehart*, 531 F.2d 1048 (C.C.P.A. 1976).

All Claim Limitations Must Be Taught or Suggested

To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). In other words, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970). If an independent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Claims 16, 17, 21, 22, 24-28, 30, 31, and 34-37 stand rejected under 35 U.S.C. § 103(a) over Klayder '323. As noted above, claims 21, 24 and 27-28 have been cancelled. Insofar as it may be applied to the present claims, this rejection is respectfully traversed.

Claim 1, as amended, is drawn to a sprayable tire dressing composition that includes an aqueous silicone microemulsion, an emulsifier system and a wetting agent. The aqueous silicone microemulsion includes amino functional silicone fluids having viscosities ranging from about 40 cSt to 500,000 cSt at room temperature dispersed in water. The emulsifier system includes surfactants and cosurfactants having interfacial functionalities to emulsify and disperse the silicone fluids in the water to the extent that the dispersed silicone fluids have a droplet size of from 10 to 100 microns. The wetting agent is a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent for reducing the surface tension of the silicone fluids.

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Claim 22, as amended, is drawn to a method of forming a durable, shiny, water repellant coating on a tire by spraying on the surface of the tire a composition as set forth in claim 1.

Applying the criteria set forth above, it is clear that Klayder '323 does not teach, motivate or suggest all of the limitations of claims 1 and 22 or claims 16, 17, 25-26, 30, 31, and 34-37 which depend, directly or indirectly, from and include the subject matter of claim 1 or claim 22.

Specifically, Klayder '323 does not disclose or suggest a sprayable tire dressing composition or a method of forming a coating on a tire by spraying on the surface thereof a tire dressing composition.

In addition, there is no suggestion or motivation to modify Klayder '323 to include all of the limitations of claims 1 and 22. The necessary modification of the compositions of Klayder '323 would involve modifying the gelled compositions to be sprayable which likely would require removing the acrylic thickener from such compositions. There is no evidence in the record that would provide a suggestion or motivation for such a modification of the gelled compositions of Klayder '323. Without a proper suggestion or motivation to modify the gelled compositions of Klayder '323 to be sprayable, there could be no reasonable expectation of success.

Accordingly, Applicants submit that a prima facie case of obviousness over Klayder '323 has not been made with respect to claims 1 and 22 because none of the three criteria of the prima facie case has been satisfied. Applicants further submit that the prima facie case also fails with respect to claims 16, 17, 25-26, 30, 31, and 34-37, each of which depends, directly or indirectly, from claims 1 or 22 for at least the same reasons as noted above with respect to claims 1 and 22.

In view of the foregoing, Applicants request that the rejection of claims 16, 17, 21, 22, 24-28, 30, 31, and 34-37 under 35 U.S.C. § 103(a) over Klayder '323 be withdrawn.

Claims 10, 11, 16 and 17 stand rejected under 35 U.S.C. § 103(a) over Mondin '983. Insofar as it may be applied to the present claims, this rejection is respectfully traversed.

Claim 1, as amended, is drawn to a sprayable tire dressing composition that includes an aqueous silicone microemulsion, an emulsifier system and a wetting agent. The aqueous silicone microemulsion includes amino functional silicone fluids having viscosities ranging from about 40 cSt to 500,000 cSt at room temperature dispersed in water. The emulsifier system includes surfactants and cosurfactants having interfacial functionalities to emulsify and disperse the

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silicone fluids in the water to the extent that the dispersed silicone fluids have a droplet size of from 10 to 100 microns. This wetting agent is a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent for reducing the surface tension of the silicone fluids.

Applying the criteria set forth above, it is clear that Mondin '983 does not teach, motivate or suggest all of the limitations of claim 1 or claims 10, 11, 16 and 17 which depend, directly or indirectly, from and include the subject matter of claim 1.

Specifically, Mondin '983 does not disclose or suggest a sprayable tire dressing composition that includes an aqueous silicone microemulsion in which the aqueous silicone microemulsion includes amino functional silicone fluids having viscosities ranging from about 40 cSt to 500,000 cSt at room temperature dispersed in water.

In addition, there is no suggestion or motivation to modify Mondin '983 to include all of the limitations of claim 1. Without a proper suggestion or motivation to modify the microemulsion compositions of Mondin '983 that include an anionic surfactant, a polyalkylene oxide-modified polydimethyl siloxane, a secondary alcohol, an ethoxylated polyhydric alcohol type compound, magnesium sulfate heptahydrate and perfume to further include an aqueous silicone microemulsion in which amino functional silicone fluids having viscosities ranging from about 40 cSt to 500,000 cSt at room temperature are dispersed in water, there could be no reasonable expectation of success.

Accordingly, Applicants submit that a prima facie case of obviousness over Mondin '983 has not been made with respect to claim 1 because none of the three criteria of the prima facie case has been satisfied. Applicants further submit that the prima facie case also fails with respect to claims 10, 11, 16 and 17, each of which depends, directly or indirectly, from claim 1 for at least the same reasons as noted above with respect to claim 1. In view of the foregoing, Applicants request that the rejection of claims 1, 11, 16 and 17 under 35 U.S.C. § 103(a) over Mondin '983 be withdrawn.

Claims 1-6, 8-12, 14-19, 21, 22, 24-28, 30-34, 36 and 37 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,661,208 to Bass ("Bass '208") in view of U.S. Patent No. 5,183,845 to Parkinson et al. ("Parkinson '845"). As noted above, claims 2, 5-6, 19, 21, 24 and 27-28 have been cancelled. Insofar as it may be applied to the present claims, this rejection is respectfully traversed.

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As noted above, claim 1, as amended, is drawn to a sprayable tire dressing composition that includes an aqueous silicone microemulsion, an emulsifier system and a wetting agent. The aqueous silicone microemulsion includes amino functional silicone fluids having viscosities ranging from about 40 cSt to 500,000 cSt at room temperature dispersed in water. The emulsifier system includes surfactants and cosurfactants having interfacial functionalities to emulsify and disperse the silicone fluids in the water to the extent that the dispersed silicone fluids have a droplet size of from 10 to 100 microns. The wetting agent is a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent for reducing the surface tension of the silicone fluids.

Claim 22, as amended, is drawn to a method of forming a durable, shiny, water repellant coating on a tire by spraying on the surface of the tire a composition as set forth in claim 1.

Applying the criteria set forth above, it is clear, that Estes '208 and Parkinson '845, alone or in combination, do not teach, motivate or suggest all of the limitations of claims 1 and 22 or claims 3-4, 8-12, 14-18, 25-26, 30-34, 36 and 37 which depend directly or indirectly, from and include the subject matter of claim 1 or claim 22.

Specifically, Estes '208 relates to a rubber or vinyl surface protectant that includes a silicone component and an acrylic component. As disclosed at col. 1, lines 62-65 of Estes '208, the silicone component of the protectant composition is an aqueous emulsion or microemulsion of a polydimethylsiloxane that is stabilized by one or more ionic or nonionic surfactants. The siloxane microemulsions of Estes '208 include siloxane particles having a diameter of 0.05 micrometers to 0.35 micrometers, see col. 2, lines 36-65 of Estes '208.

In contrast, claim 1 is directed to a tire dressing composition and claim 22 is directed to a method of forming a coating on a tire by applying to the surface thereof a tire dressing composition that includes an aqueous silicone microemulsion in which amino functional silicone fluids having viscosities ranging from about 40 cSt to 500,000 cSt at room temperature are dispersed in water and the dispersed silicone fluids have a droplet size of from 10 to 100 microns.

Estes '208 does not disclose a composition or a method of forming a coating by spraying on the surface of a tire a tire dressing composition that includes an aqueous silicone microemulsion in which amino functional silicone fluids having viscosities ranging from about 40 cSt to 500,000 cSt at room temperature are dispersed in water and the dispersed silicone



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fluids have a droplet size of from 10 to 100 microns. Accordingly, Estes '208 does not disclose each and every element of independent claims 1 and 22.

Parkinson '845 was cited for its disclosure of Silwet L-77 and 7607 but does not supply the deficiencies of Estes '208 with respect to the composition of claim 1 or the method of claim 22.

Accordingly, Estes '208 and Parkinson '845 fail to teach, motivate or suggest all of the limitations of independent claims 1 and 22 or the claims dependent thereon, namely, claims 3-4, 8-12, 14-18, 25-26, 30-34, 36 and 37. Therefore, the third criterion of a *prima facie* case of obviousness is not met because neither Estes '208 or Parkinson '845, alone or in combination teach each and every element of the claimed invention.

In addition, there is no suggestion or motivation to modify Estes '208 or Parkinson '845 to include all of the limitations of claims 1 and 22. Without a proper suggestion or motivation for modification of Estes '208 or Parkinson '845 to include an aqueous silicone microemulsion in which amino functional silicone fluids having viscosities ranging from about 40 cSt to 500,000 cSt at room temperature are dispersed in water and the dispersed silicone fluids have a droplet size of from 10 to 100 microns, there could be no reasonable expectation of success.

Accordingly, Applicants submit that the *prima facie* case of obviousness over Estes '208 in view of Parkinson '845 has not been made with respect to claims 1 and 22 because none of the three criteria of the *prima facie* case has been satisfied. Applicants further submit that the *prima facie* case also fails with respect to claims 3-4, 8-12, 14-18, 25-26, 30-34, 36 and 37, each of which depends, directly or indirectly, from claims 1 or 22 for at least the same reasons as noted above with respect to claims 1 and 22.

In view of the foregoing, Applicants request that the rejection of claims 1-6, 8-12, 14-19, 21, 22, 24-28, 30-34, 36 and 37 under 35 U.S.C. § 103(a) over Estes '208 in view of Parkinson '845 be withdrawn.

#### D. Conclusion

Claims 1, 3-4, 8-18, 22, 25-26 and 30-34 are now pending in the present application. In view of the foregoing, allowance of all pending claims is respectfully requested.

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The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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